

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

MCLAU-01

First named inventor: Patricia McLaughlin

Application No.: 09/863,644

Art Unit: 3711

Filed: 05/23/2001

Examiner: Mendiratta, Vishu K

Title: Game Apparatus and Method of Play

RECEIVED
NOV 09 2005
OFFICE OF PETITIONS

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

- ☒ Small entity-fee \$ 750.00 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.
- ☐ Other than small entity - fee \$ _____ (37 CFR 1.17(m))

2. Reply and/or fee

- A. The reply and/or fee to the above-noted Office action in the form of Response to Office Action (identify type of reply):

- ☐ has been filed previously on _____
- ☒ is enclosed herewith.

- B. The issue fee and publication fee (if applicable) of \$ _____

- ☐ has been paid previously on _____
- ☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

11/08/2005 NGUYEN1 00000013 09863644 750.00 DP
01 FC:2453

3. Terminal disclaimer with disclaimer fee

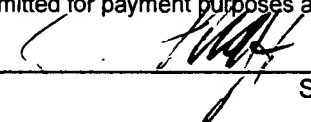
☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.



Signature

November 4, 2005

Date

Mitchell A. Stein

Typed or printed name

30,978

Registration Number, if applicable

24 Woodbine Avenue, Suite 4

Address

631-757-8400

Telephone Number

Northport, New York 11768

Address

Enclosures: ☒ Fee Payment☒ Reply☐ Terminal Disclaimer Form☐ Additional sheets containing statements establishing unintentional delay☒ Other: *Postcard***CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]**

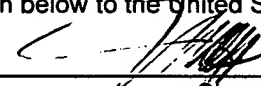
I hereby certify that this correspondence is being:

☒ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (571) 273-8300.

November 4, 2005

Date



Signature

Mitchell A. Stein

Typed or printed name of person signing certificate

PATENT

Docket No. MCLAU-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PATRICIA McLAUGHLIN

Examiner: Mendiratta, V.K.

Serial No.: 10/278,196

Art Unit : 3712

Filed: October 22, 2002

For: GAME APPARATUS AND
METHOD OF PLAY

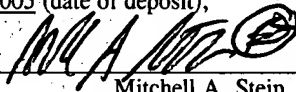
RECEIVED
NOV 09 2005
OFFICE OF PETITIONS

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

Pursuant to 37 C.F.R. §1.8(a), I hereby certify that this correspondence is being deposited with the U.S. Postal Service, postage prepaid, for first class mailing to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on November 4, 2005 (date of deposit),

by:


Mitchell A. Stein
Reg. No. 30,978

PETITION FOR REVIVAL

S I R :

Applicant respectfully submits this Petition for Revival and response to Office Action dated March 26, 2004. Applicant hereby states that the entire delay in filing the required reply from the due date for the reply until the filing of this petition for revival was unintentional. Applicant includes herewith the proscribed Small Entity fee of \$750.00, pursuant to 37 C.F.R. 1.17(m), by credit card. Form PTO-2038 (completed) is attached as well as the Petition form PTO/SB/64.

INTRODUCTORY STATEMENT

Applicant amends the claims as indicated, and provides remarks, as indicated obviating the rejections contained in the aforementioned Office Action allegedly under 35 U.S.C. § 102 and 103(a), respectively. Accordingly, a Notice of Allowance is respectfully sought.

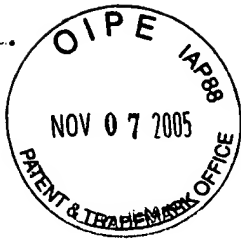


TABLE OF CONTENTS

#10/Amendment
A

INTRODUCTORY STATEMENT	1
TABLE OF CONTENTS	2
AMENDMENTS TO THE CLAIMS	3
(A) CLAIM AMENDMENTS	5
(B) CLAIM LISTINGS	8
(C) CLAIM TEXT IN CLEAN VERSION	10
REMARKS	11

10

AMENDMENTS TO THE CLAIMS

CLAIM AMENDMENTS

- 1. (Amended) A game apparatus for play by at least two players, comprising:
- (a) a plurality of manually placeable game pieces;
 - (b) at least four slideably mounted, apertured slats, each having at least four apertures thereupon for receiving one or more of the game pieces;
 - (c) a base assembly for slideably mounting said slats, such that said slats can be moved, and said game pieces placed in said apertures, at the option of each of said at least two players, in serial, turned order, wherein said base assembly does not contain home positions at opposite ends of the board.
- 6. (Amended) A method of playing a game by two players on a game apparatus having a game surface comprised of a plurality of apertured slats, slidably mounted in a base assembly such that each of said slats can be moved in a bidirectional, linearly displaceable, sequential, stopwise manner that reassembles the appearance of the game surface, comprising:
- (a) selecting a color specific to each of the players;
 - (b) wherein each of said players, in serial, turned order, selects a move selected from one of two possible moves, said two possible moves comprising:
 - (1) placing a game piece in one of said apertures on one of said slats;
and
 - (2) sliding one of said slatted portions linearly in one of the two
bidirectional manners, to the next, sequential stop;

- (c) repeating step (b) until one of the players has placed a predetermined number of game pieces in a predetermined arrangement, rather than merely moving playing pieces from one side of the board to the other.

CLAIM LISTINGS

Claim 1 (currently amended) A game apparatus for play by at least two players, comprising:

- (a) a plurality of manually placeable game pieces;
- (b) at least four slideably mounted, apertured slats, each having at least four apertures thereupon for receiving one or more of the game pieces;
- (c) a base assembly for slideably mounting said slats, such that said slats can be moved, and said game pieces placed in said apertures, at the option of each of said at least two players, in serial, turned order, wherein said base assembly does not contain home positions at opposite ends of the board.

Claim 2 (previously presented) The game apparatus of claim 1, wherein said plurality of game pieces are grouped into two groups distinguished by each group possessing a different color.

Claim 3 (previously presented) The game apparatus of claim 1, wherein said slats number in total the same number as said apertures.

Claim 4 (previously presented) The game apparatus of claim 3, wherein said number is four.

Claim 5 (previously presented) The game apparatus of claim 3, wherein said number is eight.

Claim 6 (currently amended) A method of playing a game by two players on a game apparatus having a game surface comprised of a plurality of apertured slats, slidably mounted in a base

assembly such that each of said slats can be moved in a bidirectional, linearly displaceable, sequential, stopwise manner that reassembles the appearance of the game surface, comprising:

- (a) selecting a color specific to each of the players;
- (b) wherein each of said players, in serial, turned order, selects a move selected from one of two possible moves, said two possible moves comprising:
 - (1) placing a game piece in one of said apertures on one of said slats;
and
 - (2) sliding one of said slatted portions linearly in one of the two bidirectional manners, to the next, sequential stop;
- (c) repeating step (b) until one of the players has placed a predetermined number of game pieces in a predetermined arrangement, rather than merely moving playing pieces from one side of the board to the other.

Claim 7 (previously presented) The method of claim 6, wherein the number of slats and number of apertures are the same.

Claim 8 (previously presented) The method of claim 7, wherein, the number is four.

Claim 9 (previously presented) The method of claim 7, wherein the number is eight.

Claim 10 (previously presented) The method of claim 6, wherein the arrangement is linear

Claim 11 (previously presented) The method of claim 7, wherein the arrangement is linear, and the linear number equals the number.

Claim 12 (previously presented) The method of claim 6, wherein the arrangement is a diamond.

Claim 13 (previously presented) The method of claim 6, wherein the apparatus is virtual, presented in a computer-assisted manner, and the method is practiced by entering data via a controller.

CLAIM TEXT IN CLEAN VERSION¹

1. A game apparatus for play by at least two players, comprising:
 - (a) a plurality of manually placeable game pieces;
 - (b) at least four slideably mounted, apertured slats, each having at least four apertures thereupon for receiving one or more of the game pieces; and
 - (c) a base assembly for slideably mounting said slats, such that said slats can be moved, and said game pieces placed in said apertures, at the option of each of said at least two players, in serial, turned order, wherein said base assembly does not contain home positions at opposite ends of the board.
2. The game apparatus of claim 1, wherein said plurality of game pieces are grouped into two groups distinguished by each group possessing a different color.
3. The game apparatus of claim 1, wherein said slats number in total the same number as said apertures.
4. The game apparatus of claim 3, wherein said number is four.
5. The game apparatus of claim 3, wherein said number is eight.

¹The Rules remain so unclear, that in the interests of full assurance of compliance, all claims in clean version, including those amended, are listed in this section with the amendments already in place. If this is deemed beyond that which is required by the Rules (which is the undersigned's belief), then it may be disregarded.

6. A method of playing a game by two players on a game apparatus having a game surface comprised of a plurality of apertured slats, slidably mounted in a base assembly such that each of said slats can be moved in a bidirectional, linearly displaceable, sequential, stopwise manner that reassembles the appearance of the game surface, comprising:

- (a) selecting a color specific to each of the players;
- (b) wherein each of said players, in serial, turned order, selects a move selected from one of two possible moves, said two possible moves comprising:
 - (1) placing a game piece in one of said apertures on one of said slats;
and
 - (2) sliding one of said slatted portions linearly in one of the two bidirectional manners, to the next, sequential stop;
- (c) repeating step (b) until one of the players has placed a predetermined number of game pieces in a predetermined arrangement rather than merely moving playing pieces from one side of the board to the other.

7. The method of claim 6, wherein the number of slats and number of apertures are the same.

8. The method of claim 7, wherein, the number is four.

9. The method of claim 7, wherein the number is eight.

10. The method of claim 6, wherein the arrangement is linear

11. The method of claim 7, wherein the arrangement is linear, and the linear number equals the number.

12. The method of claim 6, wherein the arrangement is a diamond.

13. The method of claim 6, wherein the apparatus is virtual, presented in a computer-assisted manner, and the method is practiced by entering data via a controller.

REMARKS

In the Office Action dated March 26, 2004, the Examiner rejected claims 1-4 under 35 U.S.C. § 102 as allegedly being anticipated by Shoptaugh (U.S. Patent No. 3,731,934). The Examiner also rejected claims 3-5, and 6-13 allegedly as being anticipated by Shoptaugh (U.S. Patent No. 3,731,934) or, in the alternative, under 35 U.S.C. § 103(a) as being allegedly obvious over Shoptaugh (U.S. Patent No. 3,731,934). Reconsideration and withdrawal of these rejections, and issuance of a Notice of Allowance is respectfully requested in light of the amendments to the claims set forth herein and the remarks set forth hereinbelow. All amendments have been made herein without prejudice.

Claims 1-13 remain in this application, as amended above, with independent claims 1 and 6.

With respect to the Examiner's first concern under 35 U.S.C. § 102, applicant respectfully submits that the instant application is easily distinguishable from Shoptaugh (U.S. Patent No. 3,731,934). [Firstly, applicant would like to bring to Examiner's attention that the game apparatus and method of play described in instant application and as now claimed contains elements not included in Shoptaugh which themselves, we submit, obviate the rejection.] Specifically, Shoptaugh fails to describe a game apparatus whereby a winner is determined when a player has a predetermined number of game pieces, the game pieces always numbering more than one, in a predetermined arrangement (such as a diamond, square, or other arrangement). To the contrary, Shoptaugh describes a game apparatus whereby a winner is determined by moving a single playing piece from one side of the board to the other before his opponent. Clearly the subject application and Shoptaugh describe separate and distinct inventions. However, to form the basis for a 35 U.S.C. § 102 rejection, one "must show that

McL

each element of the claim in issue is found, either expressly described or under principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice." *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771 (C.A.Fed.,1983). This Shoptaugh utterly fails to do and thus, we submit, cannot form the basis for a 35 U.S.C. § 102 rejection of the instant invention.

which
element?
in
Shoptaugh
clear

The fact that a winner must arrange a plurality of game pieces in a predetermined arrangement, rather than simply move one game piece from one side of the board to the other, is critical to the subject invention, as described repeatedly as such throughout the specification (See, for example, pages 3, 6, and 11).

Case law has consistently held that the standard and application of anticipation is strict. "The invention must be disclosed within the four corners of a single reference or description and such disclosure must be shown by clear and convincing evidence." *Nordberg Inc. v. Telsmith, Inc.*, 881 F.Supp. 1252, 1282 (E.D.Wis.,1995). See also *Johns-Manville Corp. v. Guardian Industries Corp.*, 586 F.Supp. 1034, 1054 (D.C.Mich.,1983); *Hart v. Baarcke*, 396 F.Supp. 408, 412 (D.C.Fla.1975); *Warner-Jenkinson Co. v. Allied Chemical Corp.*, 477 F.Supp. 371, 383 (D.C.N.Y., 1979). It is therefore clear that a 35 U.S.C. § 102 rejection cannot be based on Shoptaugh as it does not satisfy the "four corners test" set forth above. Hence, because the instant application describes an invention which was neither patented, described in a printed application, nor in public use or on sale more than one year prior to the date of the instant application, as demonstrated above, applicant respectfully requests that Examiner withdraw the rejection based on 35 U.S.C. § 102.

With respect to the Examiner's contention under 35 U.S.C. § 103 that the instant application is allegedly obvious over Shoptaugh (U.S. Patent No. 3,731,934) applicant respectfully submits that the instant application as amended is not obvious over the above-

referenced patent for the distinct reasons, set forth above and further expanded upon herein below, for purposes of clarification. "Obviousness, 35 U.S.C. § 103, is reviewed as a legal conclusion based upon underlying facts of four general categories, viz. the scope and content of the prior art, the differences between the prior art and the claimed invention, the level of ordinary skill at the time the invention was made, and any objective considerations that may be present." *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1270 (C.A.Fed. (Ohio),1991).

method The subject invention is directed to a game apparatus and method of play, whereby a winner is determined when a player has a predetermined number of game pieces (more than one) in a predetermined arrangement (such as a diamond, square, or other arrangement) which is critical and repeatedly stated as such throughout the specification. (See, for example, pages 3, 6, and 11). Respectfully, none of these critically inventive elements are even hinted at, let alone shown by the prior art. To the contrary, Shoptaugh describes a game apparatus whereby a winner is determined by moving his playing pieces from one side of the board to the other before his opponent. The differences between the subject matter contained in the subject invention and the prior art cited by the Examiner (Shoptaugh) are not obvious to one of skill in the art. "(T)he obviousness test of s 103 is not one which turns on whether an invention is equivalent to some element in the prior art but rather whether the difference between the prior art and subject matter in question is a difference sufficient to render the claimed subject matter unobvious to one skilled in the applicable art." *Dann v. Johnston*, 425 U.S. 219, 228, 96 S.Ct. 1393, 47 L.Ed.2d 692 (1976). Indeed, upon inspection of Shoptaugh, the game apparatus cannot be adapted to, nor does it suggest, a game apparatus whereby a winner is determined when a player has a predetermined number of game pieces (more than one) in a predetermined arrangement (such as a diamond, square, or other arrangement). Moreover,

because Shoptaugh teaches that each player uses only one game piece, it is inherently impossible for the user to arrange the game piece in any desired arrangement. The fact that the instant invention uses a plurality of game pieces for each player allows each player to arrange said game pieces in any desired arrangement. As at least these critical elements are absent from the prior art (Shoptaugh), Shoptaugh cannot alone form the basis for a rejection under 35 U.S.C. § 103.

The instant invention describes computer applications of the game, not anywhere taught in Shoptaugh, which is the only prior art cited by the Examiner. "A nexus is required between the merits of the claimed invention and the evidence offered, if that evidence is to be given substantial weight enroute to conclusion on the obviousness issue." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1539 (C.A.Fed.,1983). As at least these critical elements are absent from the prior art (Shoptaugh), the required nexus is lacking and Shoptaugh therefore cannot alone form the basis for a rejection under 35 U.S.C. § 103.

Furthermore, the instant invention allows players to predetermine different arrangements in order to determine a winner, which allows said users to make the game more or less challenging, as the player desires. To the contrary, Shoptaugh allows players to vary the degree of difficulty only by increasing the number of slats and apertures in the game apparatus. To form the basis for a rejection under 35 U.S.C. § 103, the disclosure must be "sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function." *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (C.A.Fed. (Ohio),1991). In this case, is inherently impossible for the invention in Shoptaugh to allow players to predetermine different arrangements in order to determine a winner, because each player only utilizes one game piece. As at least these critical

elements are absent from the prior art (Shoptaugh), Shoptaugh cannot alone form the basis for a rejection under 35 U.S.C. § 103.

Respectfully, in extreme contrast lies reliance upon Shoptaugh (U.S. Patent No. 3,731,934) cited against the instant invention which neither teaches nor suggests a game apparatus whereby the winner is determined by placing a predetermined plurality of game pieces in a predetermined arrangement, but rather *teaches away* from the subject invention in that Shoptaugh describes a game apparatus whereby the winner is determined by merely moving a single playing piece from one side of the board to the other. This again demonstrates that Shoptaugh cannot alone form the basis for a rejection under 35 U.S.C. § 103.

As demonstrated above, the Examiner has apparently overlooked the criticality of both the method of play, which requires a player to arrange a predetermined number of game pieces in a predetermined arrangement, and the game apparatus itself, which requires that a player use a plurality of game pieces in order to win the game. Neither of these critical aspects of subject invention are described in Shoptaugh, which the Examiner cited as forming the basis for a rejection under 35 U.S.C. § 103. "When the references cited by the Examiner fail to establish a prima facie case of obviousness [as here], the rejection is improper and will be overturned." *In re Ochiai*, 71 F.3d 1565, 1569 (C.A.Fed.,1995).

Accordingly, it is respectfully submitted that the independent claims as amended fully traverse the rejections, and the claims that depend therefrom as well overcome any teachings or hintings that may be found in the art of record. Hence, it is respectfully submitted that applicant has fully traversed the rejections contained in the Office Action, and it requested that the Examiner acknowledge the same and provide a Notice of Allowance.

No amendment herein has changed the scope of the invention, but has been provided for clarification (and to overcome the issues brought by the Examiner under 35 U.S.C. §§ 102,

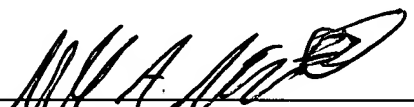
103). Accordingly, it is respectfully submitted that applicant has fully traversed the rejections contained in the Office Action, and it requested that the Examiner acknowledge the same and provide a Notice of Allowance.

Should the Examiner determine that a Notice of Allowance is not now in order, it is respectfully requested that the Examiner call undersigned counsel prior to issuance of another Office Action to discuss the same.

The Examiner's continued careful consideration of the subject application is appreciated.

Respectfully submitted,

Dated: November 4, 2005



Mitchell A. Stein
Reg. No. 30,978
STEIN LAW, P.C.
Attorneys for Applicant
24 Woodbine Ave., Suite 4
Northport, NY 11768
(631) 757-8400 (voice)
(631) 757-8404 (fax)
iplawyer@kingofip.com